

REMARKS

At the time of the Office Action dated December 5, 2006, claims 1-16 were pending and rejected in this application.

CLAIMS 7-10 ARE REJECTED UNDER 35 U.S.C. § 101

On page 2 of the Office Action, the Examiner asserted that the claimed invention, as recited in claims 7-10, is directed to non-statutory subject matter. This rejection is respectfully traversed.

As stated in M.P.E.P. § 2106(II)(A):

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971). Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.

The Examiner, however, has not made any *prima facie* case. Instead, the Examiner's has merely concluded that the claimed invention, as recited in claims 7-10 is "merely a list of the embodiments of the system and never produce a concrete result making the claims intangible." Moreover, the Examiner has failed to "expressly state how the language of the claims has been interpreted to support the rejection."

Applicants are also unclear as the legal and factual basis underpinning the Examiner's assertion that "[t]he claims limitations are merely a list of the embodiments of the system and never produce a concrete result making the claims intangible." There is no legal requirement

that the claims limitation produce a concrete result. Under State Street Bank & Trust Co. V. Signature Financial Group, Inc.,¹ the requirement is that if the invention, as a whole, produces a "useful, concrete and tangible result," then the invention is directed to statutory subject matter.

In this regard, Applicants note that a difference exists between the claimed limitations and the invention. The claims are not the invention itself. The claims (and thus the claim limitations) are intended to set the metes and bounds of the invention (i.e., to draw a fence around the subject matter Applicants regard as the invention). Therefore, there is no requirement that the claims themselves produce or recite a useful and tangible result.

Applicants also note that claims 7-10 are directed to a system, i.e., a device, and a device is clearly constitutes statutory subject matter. Therefore, for the reasons stated above, Applicants respectfully solicit withdrawal of the imposed rejection of claims 7-10 under 35 U.S.C. § 101.

**CLAIMS 1-3, 5, 11-13, AND 15 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING
ANTICIPATED BY HICKMAN ET AL., U.S. PATENT NO. 5,361,361 (HEREINAFTER HICKMAN)**

On pages 2-7 of the Office Action, the Examiner asserted that Hickman discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

¹ 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1999).

Claims 1 and 11

Independent claims 1 and 11 each recite, in part, the following limitations:

obtaining at least two separate help documents, each of said at least two separate help documents having an association with a corresponding one of separate interface units aggregated together into a single aggregated view.

To teach this limitation, on page 3 of the Office Action, the Examiner cited Figs. 5 and 6 and column 7, lines 38-59 of Hickman while asserting:

In Figure 5 Hickman shows two applications aggregated into one display screen. Further Hickman discusses for each application within the system, accessing the help file directory and extracting the help topic and subtopic descriptors. (emphasis omitted)

Applicants respectfully disagree with the Examiner's conclusions. In this regard, Applicants note that the Examiner has not properly construed a meaning for the phrase "aggregated together into a single aggregated view" (emphasis added). A dictionary definition² of the term "aggregate" is "formed by the collection of units or particles into a body, mass, or amount." The "display screen" of Hickman is not a single aggregated view, as claimed. Moreover, this display screen was not formed by the aggregation of the two applications (i.e., "APPLICATION 1" and "APPLICATION 2"). Instead, the display screen of Hickman exists separately and independently from "APPLICATION 1" and "APPLICATION 2." Therefore, Hickman fails to identically disclose all of the limitations of the claimed invention, as recited in claims 1 and 11, within the meaning of 35 U.S.C. § 102.

Independent claims 1 and 11 also recite, in part, the following limitations:

rendering said composition of help documents in a help system view responsive to a request for help initiated in said single aggregated view. (emphasis added)

² <http://www.m-w.com/dictionary/aggregate>.

To teach this limitation, on page 3 of the Office Action, the Examiner cited column 7, lines 31-34, 59-62 while asserting "Hickman discusses the use of help utility window for displaying the help topics associated with the given application on a system" (emphasis omitted). For ease of reference, the Examiner's cited passages are reproduced below:

As an initial step, a standard window or display region for the display of help directory information (denoted the help utility window) is created in processing block 612. (column 7, lines 31-34)

At the completion of this loop, the help utility window will display help topic designators for each application resident on the system. (column 7, lines 59-62)

Upon reviewing the above-cited passages, Applicants note that these passages are complete silent as to the recited "request for help initiated in said single aggregated view" (emphasis added). Therefore, Hickman further fails to identically disclose all of the limitations of the claimed invention, as recited in claims 1 and 11, within the meaning of 35 U.S.C. § 102.

Claims 2 and 12

Dependent claims 2 and 12 each recite, in part, the following limitations:

loading an index produced from a navigation view disposed within said single aggregated view;

forming a help system navigation view based upon said index; and,
rendering said help system navigation view along with said rendering of said composition of help documents.

To teach these limitations, the Examiner cited column 7, lines 35-37; column 7, lines 50-53; and column 7, lines 59-64. Upon reviewing these passages, Applicants note that none of these limitations are identically disclosed by the passages cited by the Examiner.

Claims 3 and 13

Dependent claims 3 and 13 each recite, in part, the following limitations:

rendering both a view of said composition of help documents, and individual views of said separate help documents. (emphasis added)

To teach these limitations, the Examiner cited column 6, lines 64, 66, which state "[t]hus, the present invention integrates the display and selection of help directory information from multiple applications into a single window." This passage, although describing the integration of help information from multiple application into a single window, is silent as to rendering both a view of the composition of help documents and individual views of the separate help documents.

Therefore, for the reasons stated above, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1-3, 5, 11-13, and 15 under 35 U.S.C. § 102 for anticipation based upon Hickman.

CLAIMS 4 AND 14 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON HICKMAN IN VIEW OF PALANIAPPAN ET AL., U.S. PATENT PUBLICATION No. 2002/0054152 (HEREINAFTER PALANIAPPAN)

On pages 8 and 9 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Hickman in view of Palaniappan to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 4 and 14 respectively depend from independent claims 1 and 11, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims

1 and 11 under 35 U.S.C. § 102 for anticipation based upon Hickman. The secondary reference to Palaniappan does not cure the argued deficiencies of Hickman. Accordingly, even if one having ordinary skill in the art were motivated to modify Hickman in view of Palaniappan, the proposed combination of references would not yield the claimed invention. Applicants respectfully solicit withdrawal of the imposed rejection of claims 4 and 14 under 35 U.S.C. § 103 for obviousness based upon Hickman in view of Palaniappan.

CLAIMS 7-8 AND 10 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON HICKMAN IN VIEW OF HESMER ET AL., U.S. PATENT No. 6,918,090 (HEREINAFTER HESMER)

Although Applicants disagree that the claimed invention is obvious based upon Hickman in view of Hesmer, to expedite prosecution of the Application, Applicants submit that the reference to Hesmer cannot be properly applied against the present Application under 35 U.S.C. § 103. As discussed in M.P.E.P. § 2146, a reference that qualifies as "prior art" only under 35 U.S.C. § 102(e) cannot be considered when determining whether an invention is obvious under 35 U.S.C. § 103, provided the prior art and the claimed invention were commonly owned at the time of the invention. See M.P.E.P. § 706.02(l).

Application No. 10/754,375 (the present application) and U.S. Patent No. 6,918,090 (Hesmer) were, at the time the invention was made, commonly owned by International Business Machines Corporation

Thus, under 35 U.S.C. § 103(c), the reference to Hesmer cannot be considered by the Examiner when determining whether Applicants' invention is obvious under 35 U.S.C. § 103. Applicants, therefore, respectfully submit that the imposed rejection of claims 7-8 and 10 under 35 U.S.C. § 103 for obviousness based upon Hickman in view of Hesmer is not viable and, hence, solicit withdrawal thereof.

CLAIM 9 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON HICKMAN IN VIEW OF HESMER AND MICROSOFT COMPUTER DICTIONARY 5TH EDITION (HEREINAFTER MICROSOFT DICTIONARY)

Since the reference to Hesmer cannot be considered by the Examiner when determining whether Applicants' invention is obvious under 35 U.S.C. § 103, Applicants respectfully submit that the imposed rejection of claim 9 under 35 U.S.C. § 103 for obviousness based upon Hickman in view of Hesmer and Microsoft Dictionary is not viable and, hence, solicit withdrawal thereof.

CLAIMS 6 AND 16 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON HICKMAN IN VIEW OF OFFICIAL NOTICE

On page 11 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Hickman in view of Official Notice to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 6 and 16 respectively depend from independent claims 1 and 11, and Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1 and 11 under 35 U.S.C. § 102 for anticipation based upon Hickman. The secondary reference to

Official Notice does not cure the argued deficiencies of Hickman. Accordingly, even if one having ordinary skill in the art were motivated to modify Hickman in view of Official Notice, the proposed combination would not yield the claimed invention. Applicants respectfully solicit withdrawal of the imposed rejection of claims 6 and 16 under 35 U.S.C. § 103 for obviousness based upon Hickman in view of Official Notice.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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